

**REMARKS**

Favorable reconsideration of the application is respectfully requested in light of the amendments and remarks herein.

Upon entry of this amendment, claims 23-32 will be pending. By this amendment, claims 23 and 25 have been amended. No new matter has been added.

The invention relates *inter alia* to the use of polyphenol compounds as free-radical scavengers in cigarette filters. Specifically, the inventors had unexpectedly discovered that incorporation of polyphenols or derivatives thereof in a cigarette filter makes it possible efficiently to remove the free radicals of the cytotoxic molecules of cigarette smoke during their passage through the filter.

**Section 112 Rejection of Claim 25**

Claim 25 stands rejected under 35 U.S.C. 112, first paragraph, for allegedly failing to comply with the written description requirement.

As suggested by the Examiner (Office Action page 2), claim 25 has been amended to clarify that an extract of a plant from the *Labataie* family may be obtained by extraction with an alcoholic or aqueous alcoholic solvent. These amendments are supported by the specification at page 2, lines 16-20. Thus, no new matter is added.

Accordingly, the instant claims and specification comply with the written description requirement. Consequently, Applicant requests that the Section 112, first paragraph, rejection be reconsidered and withdrawn.

**Section 103 (a) Rejection**

Claims 23-24 and 27-32 (claims 25-26 are **not** referenced in this rejection which appears at page 3, para. 4 of the Action) are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over FR 2564296, ('French patent') in view of either Greaves et al. (U.S. Pat. App. Pub. 2003/0049332), ("Greaves") or Piquer et al. (U.S. Pat. No. 6,326,504) ("Piquer") and Yanishlieva-Maslarova et al. ("Sources of Natural Antioxidants"), ("Natural Antioxidants"). Applicants urge that French patent does not disclose, suggest or motivate a skilled artisan to practice the instantly claimed invention, either alone or in combination with Greaves, Piquer or Natural Antioxidants.

Applicants take this opportunity to note that with respect to the Natural Antioxidants publication, the publication date of this document is 2001, while the December 24, 1997 priority date of the instant application is long before that publication; it is therefore submitted that any alleged teaching in the Natural Antioxidants article is not pertinent to the instant application, since said article cannot be properly applied as a reference against the instant application.

Turning now to the substance of the Section 103 rejection, the French patent relates to a cigarette filter impregnated with essential oil which "aromatizes the cigarette smoke, protects lungs and respiratory system generally due to their antiseptic power and allows supplemental retention of tars". This is unlike the instant invention, which utilizes the use of plant extracts comprising polyphenol compounds, which compounds act as scavengers for free-radicals in the cigarette smoke.

The polyphenol-containing plant extracts of the instant invention are completely different molecularly from the French patent rosemary leaf oil. The fact that the extracts are different

from essential oils is exemplified, *inter alia*, by the differences between the manufacturing process for the oil versus that for the extract. For example, water vapor treatment of rosemary leaf is used to obtain essential oils, while the polyphenolic-containing extracts of the instant invention are not water soluble; an organic solvent is used in their extraction process. Hence, the polyphenols are not the same as evidenced by their divergent solubilities in water.

Moreover, it is submitted that the essential oil used in the French patent fails to contain the rosemarinic acid, carnosic acid, carnosol and rosmarinol, which are present in the extract utilized in the instant invention. Thus, the French patent cannot suggest the present invention. Greaves, Piquet do not remedy these inherent deficiencies since they are also silent with respect to this issue.

Applicants respectfully remind the Examiner that in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowicz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Applying the law to the instant facts, Applicants urge that the French Patent, Greaves, and Piquer fail either alone or in combination to teach, suggest or motivate a skilled artisan to practice the instantly claimed invention. Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. As "obvious to try" would be the only basis by which the obviousness rejection could stand, it is respectfully submitted that the Section 103 rejection must fail for this reason as well.

In view of the foregoing, Applicant respectfully requests consideration and entry of the instant paper, and reconsideration and withdrawal of the final refusal.

### **Conclusion**

In view of the foregoing, entry of this amendment, and the allowance of this application with claims 23-32 are respectfully solicited.

In regard to the claims amended herein and throughout the prosecution of this application, it is submitted that these claims, as originally presented, are patentably distinct over the prior art of record, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. Changes that have been made to these claims were not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112. Rather, these changes were made simply for clarification and to round out the scope of protection to which Applicant is entitled.

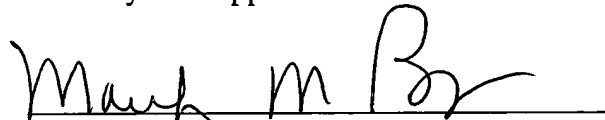
In the event that additional cooperation in this case may be helpful to complete its prosecution, the Examiner is cordially invited to contact Applicant's representative at the telephone number written below.

It is believed that no further fee is required. If, however, an additional fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicant

By:

A handwritten signature in black ink, appearing to read 'Marilyn M Brogan', written over a horizontal line.

Marilyn Matthes Brogan  
Reg. No. 31,223  
745 Fifth Avenue  
New York, New York 10151  
(212) 588-0800